United States Patent and Trademark Office

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/707,955	01/28/2004	Forrest P. Gauthier	I-27276	1954

4859	7590	09/05/2006

MACMILLAN SOBANSKI & TODD, LLC
ONE MARITIME PLAZA FIFTH FLOOR
720 WATER STREET
TOLEDO, OH 43604-1619

EXAMINER
GARCIA, GABRIEL I

ART UNIT	PAPER NUMBER
2625	

DATE MAILED: 09/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	10/707,955	GAUTHIER, FORREST P.
	Examiner	**Art Unit**	
	Gabriel I. Garcia	2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-21* is/are pending in the application.

　　4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-21* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>28 January 2004</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

　　Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

　　Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

　　a)☐ All   b)☐ Some * c)☐ None of:

　　　1.☐ Certified copies of the priority documents have been received.

　　　2.☐ Certified copies of the priority documents have been received in Application No. _____.

　　　3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

　　* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>11/05/04</u>.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

Part III DETAILED ACTION

1. This application has been examined, Claims 1-21 are pending in this application.

2. Applicant should update the serial number information with respect to the cross

reference made to the U.S. application recited on page 1 of the specification.

Double Patenting

3.   The nonstatutory double patenting rejection is based on a judicially created
doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the
unjustified or improper timewise extension of the "right to exclude" granted by a patent
and to prevent possible harassment by multiple assignees.   A nonstatutory
obviousness-type double patenting rejection is appropriate where the conflicting claims
are not identical, but at least one examined application claim is not patentably distinct
from the reference claim(s) because the examined application claim is either anticipated
by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140
F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29
USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir.
1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422
F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163
USPQ 644 (CCPA 1969).
        A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d)
may be used to overcome an actual or provisional rejection based on a nonstatutory
double patenting ground provided the conflicting application or patent either is shown to
be commonly owned with this application, or claims an invention made as a result of
activities undertaken within the scope of a joint research agreement.
        Effective January 1, 1994, a registered attorney or agent of record may sign a
terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with
37 CFR 3.73(b).

4. Claims 1-21 are rejected on the ground of nonstatutory obviousness-type double

patenting as being unpatentable over claims 1-20 of U.S. Patent No. 5,729,665.

Although the conflicting claims are not identical, they are not patentably distinct from

each other because both the pending application and the U.S. Patent No. 5,729,665.

Claims are directed to the same invention. (e.g. claim 1 from the application teaches a

computer implemented method for generating a plurality of bit maps suitable for high-

speed printing **(reads on claim 1, on the method of generating multiple bitmaps**

suitable for high speed printing of '665), comprising the steps of: (a) providing a print

specification **(reads on claim 1, e.g. the page description code defining the print**

specification of '665), the print specification the defining at least one variable static

data area **(reads on claim 1, e.g. the template data of '665)**, and at least one static

data area, and the print specification further defining at least one graphic state

associated with the variable data area, the graphic state including at least one attribute

controlling the appearance of items to be printed in the variable data area **(reads on**

claim 1, e.g. the description of the graphic state corresponding to the variable

data of '665); (b) providing a plurality of variable data items **(reads on claim 1, e.g. the**

repeatedly applying the variable data of '665); (c) processing the print specification,

and during the processing step, identifying the variable data area and the graphic state

associated with variable data area **(reads on claim 1, e.g. the description of the**

identification of step (b) of '665); (d) retrieving a variable data item from the plurality

of variable data items **(reads on claim 1, e.g. the step (c) of '665)**; (e) generating a

bitmap for the variable item, the generating step including a step of applying the graphic

state associated with the variable data area to the variable data item **(reads on claim**

1, e.g. the generating and applying steps of '665; and (f) repeating steps (d) and (e)

for remaining variable data items in the plurality of variable data items, whereby the

graphic state associated with variable data area is applied repeatedly to generate a

plurality of variable data bitmaps **(reads on claim 1, e.g. the step (f) of '665)**.

Conclusion

4.   The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure.

  Norton (6,016,380) teaches a template based edit decision list management system.

  Gauthier (5,937,153) teaches a method for utilizing variable data fields with a page

description language.

  Gauthier (5,740,338) teaches a method for merging variable image data into a

template image.

  Young (5,852,673) teaches a method for general image manipulation and composition.

5.   Any inquiry concerning this communication or earlier communications from the
examiner should be directed to Gabriel I. Garcia whose telephone number is (571) 272-
7434. The Examiner can normally be reached Monday-Thursday from 7:30 AM-6:00
PM. The fax phone number for this group is 571-273-8300.

CENTRALIZED DELIVERY POLICY: For patent related
correspondence, hand carry deliveries must be made to the Customer
Service Window (now located at the Randolph Building, 401 Dulany
Street, Alexandria, VA 22314), and facsimile transmissions must be sent
to the Central FAX number, unless an exception applies. For example,
if the examiner has rejected claims in a regular U.S. patent application,
and the reply to the examiner's Office action is desired to be transmitted
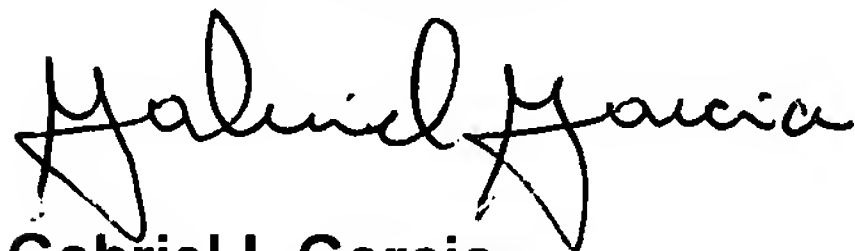by facsimile rather than mailed, the reply must be sent to the Central
FAX Number.

Any inquiry of a general nature or relating to the status of this application should

be directed to the Group receptionist whose telephone number is (571) 272-2600.

GABRIEL GARCIA
PRIMARY EXAMINER

Gabriel I. Garcia
Primary Examiner
August 31, 2006